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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,808	08/28/2001	Muneki Nakao	35.C15838	2948

5514 7590 03/27/2007  
 FITZPATRICK CELLA HARPER & SCINTO  
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 NEW YORK, NY 10112

EXAMINER
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POON, KING Y

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/939,808

**Applicant(s)**

NAKAO ET AL.

**Examiner**

King Y. Poon

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “wherein the display portion displays that there exists data to be communicated, in the case where there exists data to be communicated between the communication apparatus and the other communication apparatus, and said change portion is not able to change the communication mode to the active communication mode” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation of "wherein the display portion displays that there exists data to be communicated, in the case where there exists data to be communicated between the communication apparatus and the other communication apparatus, and said change portion is not able to change the communication mode to the active communication mode" is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 103***

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glad (US 5,773,332) in view of Wakabayashi (US 5,481,656) and Larsson et al (6,463,307).

Regarding claim 15: Glad teaches a communication apparatus (facsimile machine, column 2, lines 40-43), comprising: a wireless communication portion (the control for the facsimile machine that controls the communication using IEEE 802.11 standard, column 15, lines 20-40).

Glad does not teaches the control of fax machine has an active communication mode and power saving mode and a change portion configured to change the communication mode of the control of the communication and a display portion configured to display information about the communication mode in accordance with the change of the communication mode by the change portion.

Wakabayashi, in the same area of inventing technology designed to modified fax machine, column 40, lines 55-56, teaches to display an current mode of operation, including a power saving mode, of a controller of a fax machine (column 40, lines 40-50).

Larsson, in the area of explaining IEEE 802.11 standard, teaches IEEE 802.11 communication allows a device communication using 802.11 standard to has an active

communication mode and power saving mode and a change portion configured to change the communication mode of the communication control of the device (column 2, lines 40-51, column 2, lines 60-67).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have fully utilized IEEE 802.11 standard to modified Glad to include: the control of fax machine has an active communication mode and power saving mode and a change portion configured to change the communication mode of the control of the communication and a display portion configured to display information about the communication mode in accordance with the change of the communication mode by the change portion.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Glad because: it would have reduced energy consumption of the fax machine to reduced cost, to conserve valuable resource, and to be a good citizen as encourage by the government; it would have allowed a user to know the operation mode of the fax machine at all time and also would have reduced a lot of pain for the user for not knowing the mode of operation of the machine in the result of the machine not responding to the user the way the user thought the machine would react.

Regarding claim 16: Larsson suggested wherein the change portion changes the state of the wireless communication mode in accordance with whether or not there exists data to be communicated between the communication apparatus and other communication apparatus (416, 418, fig. 4).

Regarding claim 17: Larsson suggested wherein the change portion changes the communication mode based on a request from the communication apparatus to the other communication apparatus (408-412, fig. 4).

6. Claims 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glad (US 5,773,332) in view of Wakabayashi (US 5,481,656) and Larsson et al (6,463,307) as applied to claim 15 above, and further in view of Yoshiura et al (US 6,072,595).

Regarding claim 18: Glad does not teach wherein the display portion displays that there exists data to be communicated, in the case where there exists data to be communicated between the communication apparatus and the other communication apparatus, and said change portion is not able to change the communication mode to the active communication mode. (note: Larsson teaches that there exists data to be communicated between the communication apparatus and the other communication apparatus, when the change portion is not able to change the communication mode to the active communication mode (322-326, fig. 3))

Yoshiura, in the same area of fax machine communication, teaches display portion displays that there exists data to be communicated, in the case where there exists data to be communicated between the communication apparatus and the other communication apparatus.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Glad to include: wherein the display portion displays that there exists data to be communicated, in the case where there

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exists data to be communicated between the communication apparatus and the other communication apparatus, and said change portion is not able to change the communication mode to the active communication mode such that a operator would be notified (column 38, lines 50-58).

***Response to Arguments***

7. Applicant's arguments with respect to claims 15-18 have been considered but are moot in view of the new ground(s) of rejection. Please see detailed office action.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 23, 2007

  
KING Y. POON  
PRIMARY EXAMINER